

## REMARKS

### INTRODUCTION

Receipt of the Office Action mailed June 7, 2000 is acknowledged. Claims 26 and 32 have been amended. Claim 26 has been amended to recite that  $R^5$  is a substituted phenyl group. Claim 32 has been amended recite that the compound administered is according to formula I having the definitions set forth in the preliminary amendment filed December 15, 1998. The undersigned appreciates the indication that claims 27-29 are considered to be allowable over the prior art.

Claims 26-32 are pending in this application.

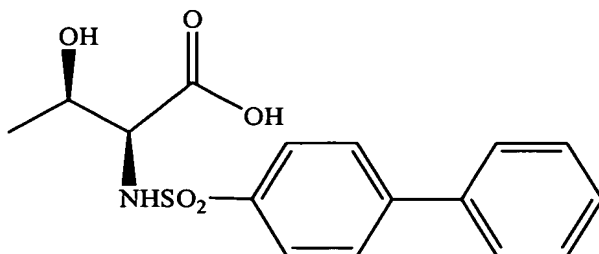
### THE OFFICE ACTION

#### *Election/Restriction*

The PTO has set forth a restriction requirement separating the claims into two separate groups. It is respectfully submitted that pursuant to the *Official Gazette* notice of March 26, 1996 which establishes guidelines for treatment of product and process claims in light of In re Ochiai, claim 32 should be included herein for consideration on the merits. Accordingly, pursuant to a telephone conference with Examiner Barts on September 1, 2000, the Examiner agreed to rejoin claim 32 for examination and consideration on the merits.

#### *Claim rejections based on 35 U.S.C. § 102*

The PTO has rejected claims 26, 30 and 31 under 35 U.S.C. § 102 as allegedly anticipated by Beilstein (5115437). Applicants respectfully traverse. Beilstein 5115437 is the abstract to Roemmele *et al.*, *J. Org. Chem.*, vol. 53, pages 2367-2371 (1988) (hereafter "Roemmele"), a copy of which is attached on the accompanying Information Disclosure Statement. Roemmele discloses the synthesis of the following compound:



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Roemmele also discloses the removal of the N-arylsulfonyl moiety with Na/NH<sub>3</sub>. The synthesis of the compound is run in the toxic solvent CH<sub>3</sub>CN (the MSDS hazardous substance fact sheet for CH<sub>3</sub>CN is attached hereto), washed with benzene (a known carcinogen) and extracted with EtOAc (the MSDS hazardous substance fact sheet for EtOAc is attached hereto). None of these substances can be considered to be acceptable for use in a pharmaceutical composition. Thus, rejection of claim 31 over Roemmele is misplaced.

Although Applicants do not acquiesce to the propriety of the rejection over Roemmele and solely in order to expedite the processing of the captioned application for entering interference proceedings with U.S. Patent No. 5,756,545, claim 26 has been amended to recite that R<sup>5</sup> is a substituted phenyl ring in the compounds of formula I. Likewise, composition claim 31 includes the recitation that R<sup>5</sup> is a substituted phenyl ring in the compounds of formula I by virtue of its dependency on claim 26.

Claim 30 is further patentable over Roemmele since claim 30 requires Y to be OH wherein the compound recites R<sup>5</sup> as a substituted phenyl ring. Accordingly, in view of Applicants' amendments and arguments, reconsideration and withdrawal of the rejection are respectfully requested.

**CONCLUSION**

In view of the foregoing, it is respectfully urged that the present claims are allowable and complete for entry into interference with U.S. Patent No. 5,756,545. An early notice to this effect is earnestly solicited. Should there be any questions regarding this application, Examiner Barts is invited to contact the undersigned at the telephone number shown below.

If there are any fees due in connection with the filing of this Amendment, please charge the fees to our Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Date

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